

Remarks

In view of the above amendments and the following remarks, favorable reconsideration of the outstanding office action is respectfully requested.

Claims 1, 3-9, and 11-24 remain in this application. Claims 1, 3, 9 and 11 have been amended. Claims 2 and 10 have been canceled. No new claims have been added

§ 103 Rejections

Claims 1-5 and 7-12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable for obviousness over Irven et al (U.S. Patent No. 4,165,224) in view of Matsumura et al (U.S. Patent No. 4,426,129).

Claim 1 has been amended to include the feature of the original claim 2. Similarly, Claim 9 has been amended to include the feature of claim 10. Claim 1 specifies a method of making a preform for an enhanced photosensitive fiber that includes the steps of collapsing the successive layers of optical material in a reducing atmosphere with a positive pressure, wherein the positive pressure is 0 to 1.0 torr. Claim 10 also includes similar language. This claimed feature is not disclosed by either Irven et al (U.S. Patent No. 4,165,224) or Matsumura et al (U.S. Patent No. 4,426,129).

In order to show prima facie case of obviousness under 35 USC § 103 the Examiner must show that all elements of the claimed invention are disclosed in the cited references and that the references themselves suggest the combination. However, the cited references do not teach, disclose or even suggest the feature of collapsing the successive layers of optical material in a reducing atmosphere with a positive pressure, wherein the positive pressure is 0 to 1.0 torr. Therefore, because the cited references either singly, or in combination, do not disclose all of the claimed features, claims 1, 3-5, 7-9 and 11-12 are not obvious over the cited references.

The Office Action (pg. 2) states: "One of ordinary skill in the art would have been able to determine overpressure value as recited in the dependent claims in order to accomplish the improved collapsing technique of Irvin et al." However, there are infinitely many values for "overpressure". Applicants claimed that the pressure has to be positive, but not higher than 1 torr. Absent a specific teaching or suggestion in the cited reference itself,

how would one of ordinary skill in the art arrived at the claimed ranges without undue experimentation?

Neither of the two cited references provides such teaching. Looking for the claimed pressure values would be like looking for a needle in a hay stack. Absent some teaching or suggestion, in the cited art itself, on what would be suitable positive pressure ranges, claims 1, 3-5, 7-9 and 11-12 are not obvious over the cited references.

Claims 6 and 13-24 stand under 35 U.S.C. § 103(a) as being unpatentable for obviousness over Irven et al (U.S. Patent No. 4,165,224) in view of Matsumura et al (U.S. Patent No. 4,426,129) as applied to claims 1-5 and 7-12, and further in view of Fanucci et al. (US Patent No. 4,465,708), Champion et al (US Patent No. 6,201,917), Ohga et al. (US Patent No. 5,763,081) or Atkins et al. (US Patent No. 5,745,615).

Applicants respectfully disagree with the grounds for this rejection. Claims 6 and 13-24 depends from either claim 1 or claim 9 as their independent claims and , therefore, expressly incorporate the language of their base claims. Therefore, claims 6 and 13-24 are unobvious for the same reasons that claims 1, 3-5, 7-9 and 11-12 are not obvious (See above).

Furthermore, claim 6 specifies that the reducing atmosphere has, in addition to GeCl_4 , at least one of He, Ar, CO, COH and 2-propanol. This feature is not disclosed by any of the cited references.

Therefore, claims 6 and 13-24 are not unpatentable for obviousness over Irven et al (U.S. Patent No. 4,165,224) in view of Matsumura et al (U.S. Patent No. 4,426,129) as applied to claims 1-5 and 7-12, and further in view of Fanucci et al. (US Patent No. 4,465,708), Champion et al (US Patent No. 6,201,917), Ohga et al. (US Patent No. 5,763,081) or Atkins et al. (US Patent No. 5,745,615).

Conclusion

Based upon the above amendments, remarks, and papers of record, Applicant believes the pending claims of the above-captioned application are in allowable form and patentable over the prior art of record. Applicant respectfully requests reconsideration of the pending claims 1, 2-9 and 11-24 and a prompt Notice of Allowance thereon.

Applicant believes that no extension of time is necessary to make this Response timely. Should Applicant be in error, Applicant respectfully requests that the Office grant

such time extension pursuant to 37 C.F.R. § 1.136(a) as necessary to make this Reply timely, and hereby authorizes the Office to charge any necessary fee or surcharge with respect to said time extension to the deposit account of the undersigned firm of attorneys, Deposit Account 03-3325.

Please direct any questions or comments to Svetlana Z. Short at 607-974-0412.

Respectfully submitted,

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